

## **REMARKS**

### **I. The Claims**

In this Amendment, claims 1 and 11 have been amended, claim 10 has been canceled, and claims 12 and 13 have been added. As a result, claims 1, 2, 4, 6 to 9, and 11 to 13 are now pending.

Claim 1 has been amended to clarify that the invention is directed to a liquid coating composition comprising at least two materials, which are (1) diphenylmethane diisocyanate; and (2) a hydroxyl functional polyester having secondary hydroxyl groups, the secondary hydroxyl groups being the product of a reaction between a carboxylic acid group and an epoxide group comprising a glycidyl ester of a C<sub>11</sub>-C<sub>20</sub> alkanolic acid. The open-ended transitional phrase "comprising" has been inserted to clarify that the liquid coating composition may comprise other materials. Another amendment to claim 1, however, clarifies that the composition comprises no other hydroxyl functional compounds. This amendment conforms claim 1 to the previously considered subject matter, wherein it has been stated that the composition of claim 1 includes only one hydroxyl functional material. See Amendment dated January 16, 2002 at pp. 4, 7, 8, 10. Claim 1 has also been amended to remove the phrase "compound which is a". This amendment has been made to make the claim language more clear, and is not intended to alter the scope of claim 1.

Claim 11 has been amended to depend from claim 1.

Claim 12 has been added. This claim depends from claim 1 and includes the limitation that the liquid coating composition of claim 1 is formulated as a two-pack composition. Support for the subject matter of this claim can be found, for example, at page 3, lines 3 to 5.

Independent claim 13 has also been added. Support for the subject matter of this claim can be found throughout the application as filed.

### **II. The Claim Rejections**

Claims 1, 2, 4, and 6-11 have been rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/30099 (hereinafter referred to as "Fenn") alone or further in view of United States Patent No. 5,712,363 (hereinafter referred to as "Noomen"). In particular, according to the Examiner, Fenn discloses the production of liquid coatings, wherein diphenylmethane diisocyanate is reacted with a polyester containing secondary hydroxyl

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groups, and a reactive diluent containing amine groups or blocked amine groups. See Office Action at 2-3.

Applicants respectfully traverse the foregoing rejections for the reasons that follow.

### **Claim 1**

Applicants respectfully traverse the Examiner's rejection of claim 1, because the Examiner has failed to establish a *prima facie* case of obviousness with respect to this claim, as amended herein. *In re Piasecki*, 745 F.2d 1468, 1471, 223 USPQ 785, 787 (Fed. Cir. 1984) (the Examiner bears the initial burden of establishing a *prima facie* case of obviousness). In particular, in this case, the prior art relied upon by the Examiner does not teach or suggest all of the limitations of claim 1. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) (to establish a *prima facie* case of obviousness, the prior art reference or combination of references must teach or suggest all the limitations of the claims). Where, as here, the Examiner does not establish a *prima facie* case of obviousness, the applicant need not submit any evidence of nonobviousness in rebuttal, and the case should proceed to allowance. *In re Rijckaert*, 9 F.3d 1531, 1352, 28 USPQ2d 1955 (Fed. Cir. 1993).

Claim 1 has been amended herein to recite that the liquid coating composition comprises no reactive diluent having amine groups or blocked amine groups. Support for the subject matter of this amendment can be found, for example, at pages 2 and 3 of the application as well as in the Examples.

Fenn neither discloses nor suggests such a composition. Indeed, as the Examiner concedes, Fenn discloses a composition comprising a reactive diluent containing amine groups or blocked amine groups. Claim 1, as currently amended, stands in direct contrast to Fenn. Moreover, the present amendment to claim 1, renders the Examiner's citation of Noomen moot. As a result, the Examiner has failed to establish a *prima facie* case of obviousness with respect to this claim. Therefore, Applicants respectfully request that the rejection of claim 1 be withdrawn.

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**Claims 2, 4, 6 to 9, and 11**

Claims 2, 4, 6 to 9, and 11 all depend, directly or indirectly, from claim 1. As a result, Applicants contend that these claims should be allowable for at least the same reasons as claim 1. Therefore, Applicants respectfully request that the rejection of these claims be withdrawn as well.

**Claim 12**

New claim 12 also depends from claim 1 and should be allowable for at least the same reasons mentioned above for claim 1. In addition, however, claim 12 also recites that the liquid coating composition is formulated as a two-pack composition. Support for this subject matter can be found, for example, in the application at page 3, lines 3 to 5.

The subject matter of claim 12 further distinguishes the present invention from Fenn. In Fenn it is stated that, because the compositions disclosed therein may have a limited pot-life, it is preferable that they be formulated as three components – adding the polyisocyanate to the reactive diluent and then adding the polyol. See Fenn at p. 8, lines 1-5.

As a result, Applicants contend that claim 12 should be allowable over Fenn alone or in combination with Noomen.

**Claim 13**

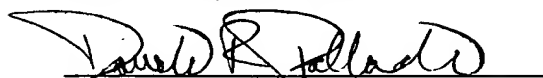
New claim 13 is an independent claim that recites a liquid coating composition comprising the same two materials recited in claim 1, which are (1) diphenylmethane diisocyanate; and (2) a hydroxyl functional polyester having secondary hydroxyl groups, the secondary hydroxyl groups being the product of a reaction between a carboxylic acid group and an epoxide group comprising a glycidyl ester of a C<sub>11</sub>-C<sub>20</sub> alkanoic acid. While claim 13 is silent as to the presence or absence of a reactive diluent having amine groups or blocked amine groups, this claim recites that the liquid coating composition is formulated as a two-pack composition. Therefore, claim 13 includes the limitation recited in dependent claim 12 and, therefore, is allowable over Fenn alone or the combination of Fenn and Noomen for the same reasons as claim 12.

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**CONCLUSION**

Applicants respectfully request entry of the foregoing amendment and allowance of the application at an early date.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Donald R. Palladino", is written over a horizontal line.

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